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EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
1713	

DATE MAILED: 08/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/040,170

Applicant(s)

EVEN, RALPH CRAIG

Examiner

Judy M. Reddick

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eb14

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06/12/03, 07/14/03 & 10/14/03.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-12 is/are pending in the application.
- 4a) Of the above claim(s) 9-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. In view of the Appeal Brief filed on 10/14/03, PROSECUTION IS HEREBY REOPENED.

New Grounds of Rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

**Claim Rejections - 35 USC § 102**

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1,2 & 4-8 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Eichman et al(U.S. 5,990,228).

Eichman et al teach aqueous coating compositions, applicable to a variety of substrates, containing at least two polymer components. More specifically, Eichmann et al teach the use of an emulsion polymer comprising a) from 40 to 90 wt. % of a first polymer governed by a Tg of from 0 to 60 degrees C and b) from 10 to 60 wt. % of a second polymer having a Tg of from 10 to 100 degrees C, with the proviso that the Tg of the second polymer is at least 10 degrees C higher than the Tg of the first polymer, in forming the aqueous coating compositions wherein the compositions are prepared via polymerizing, via conventional emulsion polymerization techniques, monomers which include (meth)acrylic monomers such as methyl, ethyl and butyl acrylate, methyl and butyl methacrylate, vinyl monomer(s) such as vinyl acetate and 0.1 to 7 wt. % of ethylenically unsaturated acid monomer(s) such as (meth)acrylic acid in the presence of 0.1 to 10 wt. % of a chain transfer agent such as dodecylmercaptan and methyl mercaptopropionate in order to control the molecular weight(the Abstract, the paragraph bridging cols. 1 & 2, col. 2, lines 39-67 to col. 3, lines 1-20 and 46-52 of Eichman et al). More specifically, Eichmann et al exemplify processes for the preparation of latexes, pH adjusted with ammonia hydroxide to greater than 8.0, that basically involve emulsion-polymerizing monomers such as butyl acrylate, methyl methacrylate and acrylic acid in the presence of surfactant, an ammonium persulfate initiator, a redox system including ferrous sulfate heptahydrate, EDTA, t-butyl hydroperoxide and isoascorbic acid and dodecylmercaptan(n-DDM), as a chain transfer agent(cols. 1-12, Runs 1-4) and the use of said latexes in formulating aqueous pigmented and clear coating compositions(col. 13, lines 1-35). Eichman et al therefore anticipate the instantly claimed invention with the understanding that the aqueous compositions of Eichman et al overlap in scope with the claimed aqueous acrylic emulsion polymer(1 & 2) and aqueous coating composition(4-8). As to the pH limitation per claims 1 & 4, adjustment of the pH of the exemplified latexes of Eichman et al to greater than 8.0 would necessarily translate to a pH during the emulsion polymerization procedure of 8.0 or lower. As to the PVC and VOC limitations(6-8), it is

reasonably expected that the aqueous pigmented coating compositions exemplified per TABLE 14 would meet the claimed PVC and VOC limitations since the compositions are essentially the same as and made under essentially the same conditions as the claimed aqueous coating compositions and in the absence of the USPTO to have at its disposal the tools and facilities deemed necessary to make physical determinations of this sort. Moreover, the aqueous pigmented coating compositions per TABLE 14 do not appear to have couched in the formulations any components that would qualify as VOCs and would inherently meet the claimed VOC content per each of claims 6-8.

It has been held that where applicants claims a composition in terms of function, property of characteristic where said function is not explicitly shown by the reference and where the Examiner has explained why the function, property or characteristics is considered inherent in the prior art, it is appropriate for the Examiner to make a rejection under both the applicable sections of 35 USC 102 and 35 USC 103 such that the burden is placed upon applicant to provide clear evidence that the respective compositions do, in fact, differ as provided for under the guise of *In re Best*, 195 USPQ 430, 433 (CCPA 1977); *In re Fitzgerald et al*, 205 USPQ 594.

When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, it is appropriate for the examiner to make a rejection under both the applicable section of 35 USC 102 and 35 USC 103 such that the burden is placed upon applicant to provide clear and convincing factual evidence that the respective products do in fact differ in kind - *In re Brown*, 59 CCPA 1063, 173 USPQ 685 (1972); *In re Fessman*, 180 USPQ 324 (CCPA 1974) - and to come forward with evidence establishing unobvious differences between the claimed product and the prior art product. *In re Marosi* 218 USPQ 290.

The disclosure of a composition of matter in a reference may be anticipatory even though the reference indicates that the composition is not preferred or even that it is unsatisfactory for the intended purpose. *In re Nehrenberg* 126 USPQ 383. Similarly, all

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disclosures of the prior art, including unpreferred or auxiliary embodiments, must be considered in determining obviousness. In re Mills, 176 USPQ 196 (CCPA 1972); In re Lamberti, 192 USPQ 278; In re Boe, 148 USPQ 507.

A reference is available for all that it teaches, including disclosures that teach away from invention as well as disclosures that point toward invention. Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 296 (Fed. Cir. 1985).

Even if it turns out that the Examiner has somehow missed the boat and the claims are not anticipated, it would have been obvious to the skilled artisan to extrapolate, from the disclosure of Eichman et al, the precisely defined aqueous acrylic emulsion polymer and aqueous coating composition, as claimed, as per such having been within the purview of the general disclosure of Eichman et al and with a reasonable expectation of success.

#### Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 2 & 4-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10/410,068 in view of Eichman et al (U.S. 5,990,228). It would have been obvious to one having ordinary skill in the art to add a redox reaction catalyzing metal salt following the examples of Eichman et al which demonstrate the use of a redox initiator system comprising ferrous sulfate heptahydrate in a conventional polymerization process for forming latex polymers derived from acrylic monomers. See the Runs of Eichman et al.

This is a provisional obviousness-type double patenting rejection.

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#### **Evidence of Common Ownership**

7. Claims 1, 2 & 4-8 are directed to an invention not patentably distinct from claims 1-7 of commonly assigned U.S. 10/410,068 as per reasons already stated in paragraph no. 6.

8. The U.S. Patent and Trademark Office normally will not institute interference between applications or a patent and an application of common ownership (see MPEP 2302). Commonly assigned Application No. 10/410,068, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CFR 1.78(c) and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application. A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Applicant is reminded of the new rules for evidence of Common ownership set forth in the OG Notice of 12/26/01 "Guidelines Setting Forth a Modified Policy the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 U.S.C. 103(c) which states: Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicants or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.

#### **Election/Restrictions**

9. Claims 9-12 stand withdrawn from consideration by the Examiner as per having been drawn to a non-elected invention, there being no allowable generic or linking claim.

#### Response to Arguments

10. After further consideration, appellant's arguments coupled with the Declaration under 37 CFR 1.132, see the Appeal Brief, filed 10/14/03, with respect to the rejection(s) of claim(s) 1, 2 & 4-8 under 35 U.S.C. 102(e)/103(a) over Slone(U.S. 6,403,703 B1) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. A new ground(s) of rejection is made in view of Eichman et al(U.S. 5,990,228) and over the claims of U.S. copending application 10/410,068 as set forth supra.

#### Conclusion

11. The additional prior art to Friel(U.S. 5,731,377), listed on the attached FORM PTO 892, is cited as of interest in teaching a polymer blend, useful as a binder in an aqueous coating composition containing no coalescent, wherein the polymer blend comprises a hard emulsion polymer and a soft emulsion polymer and considered merely cumulative to the prior art supra.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571)272-1110. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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